

REMARKS/ARGUMENTS

The office action of January 24, 2006 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-44 remain in this application. Claims 1, 12, 13, 25, 27 and 39 have been amended.

Applicants have amended the specification to correct minor informalities discovered therein.

Claims 1, 8, 9, 13, 20-22, 27, 34-36 and 41-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 5,561,446 to Montlick. Claims 2-7, 14-19 and 28-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Montlick, as applied to claims 1, 8, 9, 13, 20-22, 27, 34-36, and 41-44 above, in view of Wilcox et al. (hereinafter “Wilcox”), “Dynamite: A Dynamically Organized Ink and Audio Notebook”, CHI 97, March 1997, p. 186-193. Claims 10, 11, 23, 24, 25, 37, 38 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Montlick. Applicants respectfully traverse this rejection.

Montlick relates to a portable pen-based computer coupled by a wireless network to a host computer. The host computer supplies the portable computer with data and with forms such that handwritten data can be entered in the forms via a stylus and stored in the host computer. The handwritten data is saved as an electronic ink file associated with a particular form, which is stored separately. When the electronic ink file is recalled, the form to which the file is related is also recalled and the information is displayed in an electronic document with the electronic ink being overlaid on the form.

Claim 1, as amended, calls for, among other features, an input system that receives electronic ink data that is metadata associated with a document or file on or accessible by the computer system, a storage system that stores the electronic ink data associated with the document or file, and an ink access system that allows the operating system to access at least some of the stored electronic ink data. Montlick does not teach or suggest an input system that receives electronic ink data that is *metadata* associated with a document or file as recited in claim 1. Rather in Montlick an input system receives an electronic ink file that with a template can be recalled to form a document. Stated differently, the electronic ink input via the portable

computer is not metadata associated with the template. Moreover, Montlick lacks a teaching or suggestion of an *operating system* being allowed to access the stored electronic ink data as called for in claim 1. Instead software, which is not the operating system, but an application for creating the document including the electronic ink file and the template, accesses the electronic ink file. For at least the aforementioned reasons, Montlick does not show, describe or teach all the features of independent claim 1. Nor does Montlick render such features obvious.

Independent claims 13 and 27 are similar to independent claim 1, in at least some of the distinguishing respects discussed above. For at least this reason, claims 13 and 27 are patentably distinct from Montlick.

Wilcox fails to remedy the above defects noted with Montlick. Accordingly, the combination of Montlick and Wilcox, even if proper, does not result in the inventions recited in claims 1, 13 and 27. Claims 2-12, 14-26 and 28-40, which respectively depend from claims 1, 13 and 27, are patentably distinct from Montlick alone or in combination with Wilcox for the same reasons set forth above with respect to their ultimate base claim, and further in view of the additional advantageous features recited therein.

Independent claim 41 calls for sending data from an application program to an operating system, wherein the data requests activation of an electronic ink entry region when storing information associated with a document or file on the application program, receiving the data in the operating system, and sending a user interface including the electronic ink entry region to the application program when the application program seeks to store information associated with a document or file. The action alleges that Montlick discloses the claim 41 combination of features. On the contrary, the transmission of data from the portable computing device to the host computer does not teach or suggest sending data from an application program to an operating system. Indeed, an application running on the portable computer and the host computer merely allows for an electronic ink file with handwritten data input at the portable computer to be sent to the host computer to be stored for later retrieval to form a document with the template stored by the application at the host computer. The application is separate from the operating system which receives the data at the host computer. In addition, the user interface for entering electronic ink in Montlick is part of the application and is not sent to the application program. As such,

Montlick lacks a teaching or suggestion of sending a user interface including the electronic ink entry region to the application program when the application program seeks to store information associated with a document or file. In light of the above, claim 41 and claim 42, which depends from claim 41, are patentably distinct from Montlick.

Claim 43 calls for receiving data from an application program at an operating system, wherein the data requests activation of an electronic ink entry region when storing information associated with a document or file on the application program and sending a user interface including the electronic ink entry region to the application program when the application program seeks to store information associated with a document or file. In Montlick, an application separate from the operating system receives the data to be stored. Also, as discussed with respect to claim 41 the user interface for entering electronic ink in Montlick is part of the application and is not sent to the application program. Consequently, Montlick lacks a teaching or suggestion of sending a user interface including the electronic ink entry region to the application program when the application program seeks to store information associated with a document or file. In light of the above, claim 43 and claim 44, which depends from claim 43, are patentably distinct from Montlick.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

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